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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/706,406	11/03/2000	James P. Tagg	SC-TAG-102	7866
69296	7590	12/17/2010		
VON SIMSON & CHIN 62 WILLIAM STREET, 6TH FLOOR NEW YORK, NY 10005			EXAMINER BLAIR, DOUGLAS B	
			ART UNIT 2442	PAPER NUMBER
			MAIL DATE 12/17/2010	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/706,406

**Applicant(s)**

TAGG, JAMES P.

**Examiner**

DOUGLAS B. BLAIR

**Art Unit**

2442

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 September 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-48 is/are pending in the application.
- 4a) Of the above claim(s) 46 and 47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-45 and 48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-896)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s) Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### **Response to Amendment**

Claim 21 has been amended. Claims 21-45 and 48 are currently pending..

### **Response to Arguments**

Applicant's arguments filed 9/30/2010 have been fully considered but they are not persuasive for two reasons.

First, the applicant's specification never explicitly states that the "host system" is not authenticated to the "target system". In order for the applicant's Cooperative Tunneling Agent to function, the CTA sends both identifiers and status information to a server (page 7, first paragraph of the applicant's specification). This can clearly be considered a form of authentication of the host system, even if it does not use credentials which are specific to a host system to perform the authentication.

Second, even if the applicant had provided adequate written description, it would be obvious to omit the step of authenticating the host system in Rai according to the MPEP section 2144.04(II). Specifically, in Rai would still function the same way if the foreign service identified itself to the home server. Because the foreign service and home service already have an agreement in place, the extra step of authenticating, as opposed to just identifying, would not be necessary.

### **Claim Rejections - 35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21-45 and 48 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant's specification states the following:

Upon access by a mobile member, the CTA sends both identifiers and status information to a server. The server contains preference information on all members that can be referenced by their identifiers. The status information is compared to the preferences of the two members and, if the comparison is successful, a link to the Internet is provided to the mobile member.

Only when the host device supplies a proper identifier, is the link provided. Therefore the host device is authenticated to the target computer. The host device may not be supplying its own credentials but the claims are not that specific.

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-45 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,377,982 to Rai.

As to claim 21, Rai teaches a method (as in exemplary claim 21) of connecting a client system to a target network a step of providing software to the client system that will allow the client system to connect to the target network (col. 7, line 39-43); and a step of connecting the client system to the target network via a host system controlled by the software provided in the client system (col. 7, line 39-43), the step of connecting the client system to the target network comprising: a step of locating the target network through the host system (col. 8, lines 24-26); a step of determining requirements for connecting the client system to the target network (col. 11, lines 1-9); and a step of linking the client system to the target network based on the requirements (col. 11, lines 1-9); wherein requirements of the host system are not essential for connecting the client system to the target network (There is no disclosure in Rai that states that any requirement of the foreign service provider is necessary); however Rai does not explicitly state there is no need to authenticate the host system to the target system.

In Rai, the foreign service and home service already have an agreement in place. The extra step of authenticating, as opposed to just identifying the foreign service from the request received by the foreign service, would not be necessary.

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Rai regarding the use of a host system to locate a home network with the idea of omitting the step of authenticating because according to the MPEP section 2444.04, the omission of an element and its function is obvious if the function for the element is not desired. In this case authenticating instead of just identifying the home network would slow the process of providing access down.

As to claim 22, the foreign registration server is a server.

As to claim 23, see col. 4, line 66-col. 5, line 17.

As to claim 24, see col. 4, line 66-col. 5, line 17.

As to claim 25, see col. 5, lines 18-30.

As to claim 26, see col. 4, line 66-col. 5, line 17.

As to claim 27, see col. 4, line 66-col. 5, line 17.

As to claim 28, see col. 2, lines 33-35.

As to claim 29, see col. 6, lines 51-55.

As to claim 30, see col. 8, lines 24-26.

As to claim 31, see col. 5, lines 18-30.

As to claim 33, see col. 8, line 38-67.

As to claim 34, see col. 8, lines 24-26.

As to claim 35, see col. 24, lines 13-52.

As to claim 36, see col. 32, lines 31-60.

As to claim 38, the disclosed tunnel protocols from the foreign network to the home network read on this limitation.

As to claim 40, see col. 4, line 66-col. 5, line 17.

As to claim 41, see col. 11, lines 10-20.

As to claim 44, see col. 8, line 38-67.

As to claim 45, see col. 5, lines 18-30, the disclosed protocols coordinate frequencies.

As to claim 48, Rai does not disclose that the client has an access to any part of the host so Rai satisfies claim 48 because there is no absence to the contrary.

As to claims 32, 37, 39, 42, and 43, the point of a patent is to provide legal protection of an idea in return for putting the public in possession of novel information regarding this idea. The subject matter of claims 32, 37, 39, 42, and 43 are not explicitly discussed by Rai. A careful review of the applicant's specification shows that the applicant's disclosure does not put the public into any details on how these claims would be implemented. In order to be enabled, the applicant's disclosure implies that those of ordinary skill would know how all of these limitations are implemented. Therefore Official Notice is taken that these claims would be obvious in the context of the claimed invention. Should the applicant disagree with this characterization, the Examiner implores the applicant to point where in the applicant's specification the novelty is disclosed regarding these claims.

### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOUGLAS B. BLAIR whose telephone number is (571)272-3893. The examiner can normally be reached on 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Douglas B Blair/  
Primary Examiner, Art Unit 2442



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